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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/640,983	08/14/2003	Bill Snelson	44268.1	9201

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EXAMINER

NELSON JR, MILTON

ART UNIT

PAPER NUMBER

3636

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/640,983	<b>Applicant(s)</b> SNELSON, BILL	
	<b>Examiner</b> Milton Nelson, Jr.	<b>Art Unit</b> 3636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 30 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

The objection to claim 4 has been overcome by Applicant's amendment.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, it is unclear if Applicant intends to positively claim the combination of a seat assembly and a motorcycle passenger seat, or the subcombination of a seat assembly for use with a motorcycle passenger seat. Lines 1 to 2 appear to set forth the subcombination. Note the recitation "A seat assembly for expanding a frame mounted motorcycle passenger seat". Line 3 appears to set forth the combination. Note the recitation "a side seat cushion disposed proximate to and unattached from the passenger seat". In line 6 of claim 2, it is unclear if Applicant intends to positively claim a single or plural releasable attachment supports. Note the recitation of "one or more" releasable attachment supports. In claim 3, it is unclear if Applicant intends to positively claim the combination of a seat assembly and a motorcycle passenger seat, or the subcombination of a seat assembly for use with a motorcycle passenger seat. Lines 1 to 2 appear to set forth the subcombination. Note

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the recitation "A seat assembly for use with a motorcycle having a passenger seat".

Lines 3 to 4 appear to set forth the combination. Note the recitation "each of the seat cushions being disposed proximate to and unattached from the passenger seat".

Claims 4-6 are indefinite since each depends from an indefinite claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) he has abandoned the invention.

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

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directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(f) he did not himself invent the subject matter sought to be patented.

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Claim 1, as best understood with the above cited indefiniteness, is rejected under 35 U.S.C. 102(e) as being anticipated by Grove (6648408). Note the side seat cushion (44), side seat cushion support frame (46), side seat support (52), mounting means (62), motorcycle release attachment supports (34 on struts 18, 20), the side seat cushion extending laterally from the motorcycle passenger seat (see Figure 1).

Claim 2, as best understood with the above cited indefiniteness, is rejected under 35 U.S.C. 102(e) as being anticipated by Grove (6648408). Note the side seat cushion (44), side seat cushion support frame (46), side seat support (one of 62), mounting means (62 on the opposite side), releasable attachment supports (34), and fastening means (74, 58, 60).

***Allowable Subject Matter***

Claims 4-6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 3 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

### ***Response to Amendment/Arguments***

Applicant's response has been fully considered. Remaining issues are outlined in the above sections. Non-elected claims 7 and 8 remain withdrawn from consideration. Regarding claim 1, Applicant argues that Grove does not show a side seat cushion (44). Applicant indicates that the element (44) is a soft pad for a second seat (42). This is a side seat cushion. Applicant has amended the claim to identify the side seat cushion as distinct from the passenger seat. Side seat cushion (44) is distinct from the passenger seat. Note the illustration of side seat cushion (44) in Figures 1 and 2. In Figure 1, it can be seen that the side seat cushion is mounted rearwardly and laterally of the passenger seat (16) in a straddle-type configuration. Note that the side seat cushion is mounted on (or attached to) frame (46), which is mounted on (or attached to) struts (18, 20). In Figure 2, it can be seen that the side seat cushion can be selectively removed from any attachment with the motorcycle. Note that in Figure 1, the side seat cushion is disposed proximate to and unattached from the passenger seat.

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Note that in Figure 2, the side seat cushion is disposed proximate to and unattached from the motorcycle. Grove remains properly applied to claim 1.

Regarding claim 2, Applicant argues that Grove does not show a side seat cushion (44). Applicant indicates that the element (44) is a soft pad for a second seat (42). This is a side seat cushion. Applicant has amended the claim to identify the side seat cushion as distinct from the passenger seat. Side seat cushion (44) is distinct from the passenger seat. Note the illustration of side seat cushion (44) in Figures 1 and 2. In Figure 1, it can be seen that the side seat cushion is mounted rearwardly and laterally of the passenger seat (16) in a straddle-type configuration. Note that the side seat cushion is mounted on (or attached to) frame (46), which is mounted on (or attached to) struts (18, 20). In Figure 2, it can be seen that the side seat cushion can be selectively removed from any attachment with the motorcycle. Note that in Figure 1, the side seat cushion is disposed proximate to and unattached from the passenger seat. Note that in Figure 2, the side seat cushion is disposed proximate to and unattached from the motorcycle. Applicant further argues that the passenger seat of Grove attaches to a specialized fender strut instead of a releasable attachment support standard on numerous motorcycles. This argument appears to lack relevance as Applicant does not claim the passenger seat as attached to a releasable attachment support standard on numerous motorcycles. The claim sets forth mounting means for mounting the seat side cushion frame to one or more releasable attachment supports. In Grove, note the releasable attachment supports (34). Grove remains properly applied to claim 2.

Applicant's amendments have rendered independent claim 3, and claims dependent from claim 3, as allowable over the prior art of record, as best understood with the above cited indefiniteness. Applicant is advised that allowability is based in part on the combination of the seat assembly and the passenger seat. Arguments regarding claim 3 are now moot. Note that previously withdrawn claim 6 has been considered because of its dependency from claim 3.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



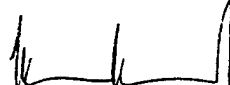
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This application contains claims 7 and 8 drawn to an invention nonelected by the Applicant. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milton Nelson, Jr. whose telephone number is (571) 272-6861. **The examiner can normally be reached on Monday-Wednesday, and alternate Fridays, 5:30-3:00.**

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Milton Nelson, Jr.  
Primary Examiner  
Art Unit 3636

mn  
March 19, 2006